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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/991,265 | 11/15/2001 | Michael A. Aveni | 005127.00078 | 3025 |

22907 7590 02/26/2004

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

EXAMINER

STASHICK, ANTHONY D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3728

DATE MAILED: 02/26/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,265

Applicant(s)

AVENT, ET AL.

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-48 is/are pending in the application.
- 4a) Of the above claim(s) 38-48 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-37 is/are allowed.
- 6) ☒ Claim(s) 1-5, 11-14 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 6-10 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 18, 2003 has been entered.

Election/Restrictions

2. Newly submitted claims 38-48 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly submitted claims are directed to a method which was not present in the application as originally filed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38-48 are hereby withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Avar et al. 6,487,796. Avar et al. '796 discloses all the limitations of the claims including the following: an upper 102 for receiving a foot of a wearer; a sole 106 attached to the upper; the sole having at least one support element (at least figures); at least one band 136 encircling the exterior surface of the support element; at least one flange attached to the at least one band (the band is shown in Figure 3 to extend flatly outward, therefore that portion of the band extending outward away from the band receiving groove is a flange on the band); the at least one flange facilitating movable positioning of the at least one band with respect to the exterior surface to thereby alter deflection and stiffness

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characteristics of the at least one support element; the one flange is formed integral with the at least one band (see definition of the band and flange above); the at least one flange is proportioned and positioned such that a hand of a wearer may grasp the at least one flange (see Figures 3 and 4).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-5 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Avar et al. 6,487,796 in view of Crary 6,457,261. Avar et al. '796 discloses substantially all the limitations of the claims including the following: an upper 102 for receiving a foot of a wearer; a sole 106 attached to the upper; the sole having at least one support element (at least 108a); the support element having an exterior surface (see figures); at least one band 136 encircling the exterior surface of the support element; a structure that facilitates movable

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positioning of the band with respect to the exterior surface (the band is shown in Figure 3 to extend flatly outward, therefore that portion of the band extending outward away from the band receiving groove is a flange on the band); the structure is attached to the band (see Figure 3); the structure is a flange extending from the band (see Figure 3); the flange is formed integral with the band (See Figure 3); the flange is proportioned and positioned to allow the user to grip the flange (user can grip extending flat portion of band); at least one indentation 124 that receives the band; the band indentation circles the support element (see Figures); there are a plurality of support elements; the support element is hollow (see Figure 3). Avar et al. '796 does not disclose the upper portion and the lower portion of the exterior surface sloping outwardly to form a ridge that encircles the at least one support element. Crary '261 teaches that the outer surface of the upper and lower portion of the support element can slope outwardly (see Figures 2, 5, 7 and 8) to allow for the telescoping collapse of the shock absorber during use. Therefore, it would have been obvious, in view of Crary '261, to slope the outer surface of the shock absorbers of Avar '796 to aid in telescoping the absorbers to aid in cushioning the impact of the user's foot with the ground.

Allowable Subject Matter

7. Claims 20-37 are allowed over the prior art of record.
8. Claims 6-10 and 15-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments filed December 18, 2003 have been fully considered but they are not persuasive. Applicant argues that the flange of the instant application is separate and then attached to the band and that Avar does not disclose a flange. This argument is not clearly understood, as previously stated, the flat portion of the band 126d extending outwardly from the support element is a flange and therefore reads on the claimed limitations.

Conclusion

10. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining

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groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

| | |
|---------------------------------|---------------------|
| Allowed Files & Publication | (703) 305-8322 |
| Assignment Branch | (703) 308-9287 |
| Certificates of Correction | (703) 305-8309 |
| Drawing Corrections/Draftsman | (703) 305-8404/8335 |
| Fee Increase Questions | (703) 305-5125 |
| Intellectual Property Questions | (703) 305-8217 |
| Petitions/Special Programs | (703) 305-9282 |
| Terminal Disclaimers | (703) 305-8408 |
| Informal Fax for 3728 | (703) 308-7769 |

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If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line
Internet PTO-Home Page

1-800-786-9199
<http://www.uspto.gov/>



Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS

February 19, 2004